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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,829	03/18/2004	Dale J. Kempf	7050.US.02	4276
23492	7590	05/14/2007		
ROBERT DEBERARDINE ABBOTT LABORATORIES 100 ABBOTT PARK ROAD DEPT. 377/AP6A ABBOTT PARK, IL 60064-6008			EXAMINER HENLEY III, RAYMOND J	
			ART UNIT 1614	PAPER NUMBER
			NOTIFICATION DATE 05/14/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/802,829	Applicant(s) KEMPF ET AL.	
	Examiner Raymond J. Henley III	Art Unit 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-10 and 12 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/27/2007</u> . | 6) <input checked="" type="checkbox"/> Other: <u>CRF Problem Report, (2 pages)</u> . |

CLAIMS 1-10 AND 12 ARE PRESENTED FOR EXAMINATION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114.

Applicant's submission, including (i) an amendment to the specification, (ii) claim listing, (iii), sequence listing, (iv) statements under 37 CFR §§ 1.82(f) and (g) and (v) a Supplemental Information Disclosure Statement, filed on February 27, 2007 has been entered.

Accordingly, the specification has been amended and, as reflected by the attached, completed copy of form PTO-1449, the cited references have been considered.

Included in the references cited is U.S. Patent Application Publication No. 2004/0192624, as well as an Office action issued during the pendency of the underlying U.S. Patent Application Serial No. 10/395,772, dated June 1, 2004. This application is currently abandoned. To the extent that similar claims were acted on in the '772 application, the following comments are deemed necessary for a complete understanding of the Examiner's determination in the present application.

In the '772 application, claims 1-4 and 13-18 were rejected under 35 U.S.C. § 102(b) as being anticipated by Norbeck et al. (U.S. Patent No. 6,037,157), based on the finding that inducing UGT1A1 isoform expression would have been inherent in the method of the patentees. This reference has been considered by the present Examiner as indicated on the form PTO-1449 dated November 26, 2004, (reference A1). Further, a rejection similar to that made in the '772

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application was made in the present application in the Office action dated April 25, 2006 at page 10, except that claims 1-4 were not subject to the rejection. Here, claims 13-18 are not pending. Present claims 1-4 require that the method is not only for inducing UGT1A1 isoform expression, but also for "treatment of a disease, disorder or adverse effect caused by an elevated serum concentration of an UGT1A1 isoform". Because Norbeck et al. fail to teach a disease, disorder or adverse effect caused by an elevated serum concentration of an UGT1A1 isoform, it is not believed that an issue of inherency exists. Also, the patentees' teachings fail to make obvious the presently claimed subject matter.

Accordingly, claims 1-10 and 12, all claims pending, are deemed allowable.

Action Under Ex Parte Quayle

This application is in condition for allowance except for the following formal matters:

This application contains a sequence disclosure that is encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). A computer readable form (CRF) of the sequence listing was submitted. However, the CRF could not be processed by the Scientific and Technical Information Center (STIC) for the reason set forth on the attached CRF Diskette Problem Report, i.e., the submitted disk was not readable.

Applicants are required to comply with the sequence rules, 37 CFR 1.821 - 1.825 and it is requested that Applicants return a copy of the attached CRF Diskette Problem Report with the reply.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213, (Comm'r Pat. 1935).

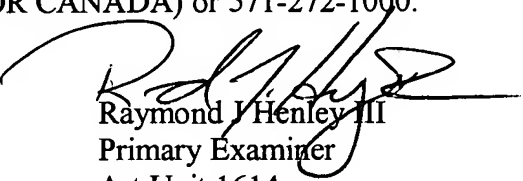
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A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond J. Henley III whose telephone number is 571-272-0575. The examiner can normally be reached on M-F, 8:30 am to 4:00 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Raymond J Henley III
Primary Examiner
Art Unit 1614

May 4, 2007